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10/033,576

11/09/2001

Robert J. Greenberg

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EXAMINER

OROPEZA, FRANCES P

ART UNIT

PAPER NUMBER

3766

MAIL DATE

DELIVERY MODE

02/19/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---|--|
| Office Action Summary | Application No. 10/033,576 | Applicant(s) GREENBERG ET AL. | |
| | Examiner FRANCES P. OROPEZA | Art Unit 3766 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/19/07 (Election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 271,332-337 and 340 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 271,332-337 and 340 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/9/01;9/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/ Restriction

1. Species II was elected by the Applicant, and claims 271, 332-337 and 340 were identified as reading on the elected species of the invention. The remaining claims were cancelled.

The election was made by the Applicant without traverse in the reply filed on 12/19/07.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 271, 332-337 and 340 are rejected under 35 U.S.C. 102(b) as being anticipated by Byers et al. (U.S. Patent No. 4,969,468).

As related to claim 271, Byers et al. disclose an implantable electrode array for making multiple electrical cellular contracts with tissue (abstract; col. 4 @ 26-27), this disclosure accepted to meet the intended use as a visual prosthesis, as scaling devices to larger and smaller scales depending on the intended use is disclosed by Byers et al. (col. 10 @ 17-20) and, comprising:

- an electrode array body (Figure 6 – 12, 13) suitable to be placed in an epiretinal location, this disclosure accepted to meet the intended use as an epiretinal implant as discussed above;
- insulation covering said electrode array body forming voids (Figure 7 – 15); and

- a plurality of electrodes recessed within said voids (Figure 7 – 14, Figure 6 – 12, 13).

As related to claim 323, Byers et al. disclose electrodes exposed in more than one dimension (Figure 7 – 14, Figure 6 – 12, 13).

As related to claim 333, Byers et al. disclose the plurality of electrodes having different lengths (Figure 11 – 31, 32).

As related to claim 334, Byers et al. disclose the plurality of electrodes having a spike-shaped (Figure 6 – 12, 13; Figure 11 – 31, 32).

As related to claim 335, Byers et al. disclose the electrode array body comprising an integrated circuit (Figure 6 – 7; col. 10 @ 29-30; Figure 12 – 33-38; col. 7 @ 63-66).

As related to claim 336, Byers et al. disclose the electrode array body having a generally curved surface on at least one side (col. 10 @ 17-20).

As related to claim 337, Byers et al. disclose the plurality of electrodes being metal and at least partially coated in ceramic (Figure 7; col. 6 @ 63-68).

As related to claim 340, Byers et al. disclose insulation covering the plurality of electrodes such that the plurality of electrodes form capacitors with the retina (col. 3 @ 64-68).

Drawings

4. The drawings are objected to because Figures 16a and 16b show reference numerals 1601-1605, 1610 and 1611 yet the Examiner is unable to find these reference numerals in the specification. Appropriate correction is required.

The Examiner requests the specification and drawings be reviewed to ensure all reference numeral have explanations, and all reference numerals in the specification are found in the Figures.

Specification

5. The specification is objected to because the Examiner is unable to find in the Figures:
- Reference numeral "820" in the specification on page 22, line 14 and on page 24, line 1, and - -
 - Reference numeral "811", elongate electrodes, noted in the specification on page 24, line 1.
- Appropriate correction is required.

Abstract

6. The abstract of the disclosure is objected to because of the length and because it does not describe the claimed invention. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fran Oropeza whose telephone number is (571) 272-4953. Fran's schedule typically is Monday and Tuesday 9AM-7PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on (571) 272-4949. Carl's schedule typically is Monday, Wednesday, Friday 9AM–5 PM EST; Tuesday, Thursday 9AM–3PM and 9PM–11PM EST. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and for After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Frances P. Oropeza/
Patent Examiner, Art Unit 3766

/Carl H. Layno/
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